



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,320	10/17/2001	Michael J. Russell	2502695-991200	6571
29585	7590	09/15/2004	EXAMINER	
GRAY CARY WARE & FREIDENRICH LLP 153 TOWNSEND SUITE 800 SAN FRANCISCO, CA 94107			GIBSON, ROY DEAN	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 09/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,320

Applicant(s)

RUSSELL, MICHAEL J.

Examiner

Roy D. Gibson

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,21-23,30,32,35,46-48 and 50-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 19,32 and 57 is/are allowed.
- 6) ☐ Claim(s) 21-23,30,35,46-48,50-56 and 58-62 is/are rejected.
- 7) ☐ Claim(s) 63-66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Entry of Amendment

Applicant's amendment filed on June 29, 2004 is acknowledged. Claims 1-18, 20, 24-29, 31, 33-34, 36-45 and 49 have been canceled by the applicant, thus claims 19, 21-23, 30, 32, 35, 46-48 and 50-66 are currently pending.

Prior Rejections or Objections

The following comments pertain to the rejections or objections in the most recent Office action, mailed on Feb. 25, 2004. Several rejections under 102 and 103 are withdrawn, however, new grounds of rejection are presented below.

Claim Objections

Claim 19 is objected to because of the following informalities: in line 4, "shaped" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30, 35, 46-48, 50-56 and 58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

Art Unit: 3739

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The current rating limitations for the fuses in these claims are not supported by the specification since no electrode areas are disclosed, only a 2 mA r.m.s./cm² as on p. 8, line 4, as a maximum current safety limit and, thus, are considered new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle (3,605,728). Ogle discloses a medical electrode comprising:

a distal end for connecting to a medical device; a separable structure of the conventional snap-on type at the proximal end of the electrode; a conductive lead connected between the distal and proximal ends; and a current stoppage means being connected to the first or top, not the second or bottom member (Figure 2, # 22 and col. 1, line 24-col. 2, line 9, and lines 30-56 and col. 3, line 17-25). However, the applicant fails to disclose the criticality of the current stoppage means being located in the second or bottom member, but, only recites a preference for this location (see p. 11, lines 22-23 of the Specification). Given this lack of criticality, it would have been an obvious matter of design choice to a person of ordinary skill in the art to locate the current stoppage

Art Unit: 3739

means in the top or first member, because Applicant has not disclosed that such a location recited in these claims provides an advantage, is used for a particular purpose, or solves a stated problem.

Claims 25, 58, 60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle in view of Day (3,603,811). Ogle discloses a current stoppage means, and the examiner has argued that this means could alternatively be located in the bottom portion of the electrode as detailed above in rejection of independent claim 59. However, Ogle fails to disclose the current stoppage means consists of a fuse a diode or a circuit breaker. But, Day discloses a current limiter for a medical electrode essentially as claimed and specifically that a fuse could be used as a current limiter but with the limitation of loss of monitoring (col. 1, lines 4-57 and col. 2, lines 7-22).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Ogle, as taught by Day, to provide a fuse as an alternative equivalent to a current limiting circuit to prevent excess current to the patient.

Allowable Subject Matter

Claims 19 (when corrected), 32 and 57 are allowed.

Claims 63-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

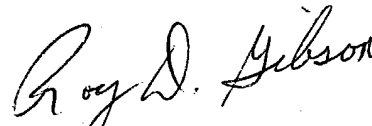
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 703-308-3520. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roy D. Gibson
Primary Examiner
Art Unit 3739

Sep. 14, 2004